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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,524	08/17/2001	Mitchell Blashinsky	4582	3729
7590 07/06/2004				
Charles I. Brodsky 2 Bucks Lane Marlboro, NJ 07746				
			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/931,524

**Applicant(s)**

BLASHINSKY, MITCHELL

**Examiner**

Naeem Haq

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US 5,758,328).**

Art Unit: 3625

Referring to claim 1, Giovannoli teaches a method for the on-line solicitation of goods and/or services by pre-identified purchasers, comprising: first, establishing a first database of pre-identified purchasers of defined categories of goods and/or services (column 3, line 55 – column 4, line 19); second, establishing a second database of vendors of said defined categories of goods and/or services (column 4, line 50 – column 5, line 8); third, interactively matching via Internet connection a request for particular goods and/or service information from a common interest purchaser to a vendor thereof (column 5, lines 9-36); and fourth, sending such information from a selected vendor to the requesting purchaser by at least one of regular mail, telephone, facsimile and electronic mail (column 5, line 37 – column 6, line 11). Giovannoli does not teach that the purchasers are common interest purchasers. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of establishing, matching, and sending would be performed the same regardless of who the purchasers were. The difference between the Applicant's invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have any type of purchaser use the invention of Giovannoli to place an order because the type of purchaser does not functionally relate to the steps of the claimed method because the

Art Unit: 3625

subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 2-4, Giovannoli teaches assigning an identifying code unique to each purchaser included within said first database (Figure 7).

**Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US 5,758,328) in view of Official Notice.**

Referring to claim 5, Giovannoli does not teach the step of a pre-billing of each vendor a cost for inclusion within said second database. However, Giovannoli teaches that each vendor applies for membership (column 4, lines 50-52). Official Notice is taken that it is old and well known in the art to charge a fee for membership. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to pre-bill each vendor for inclusion in the invention of Giovannoli. One of ordinary skill in the art would have been motivated to do so in order to offset some of the administrative costs associated with maintaining the system of Giovannoli.

Referring to claims 6 and 7, Giovannoli does not teach the step of a soliciting of common interest purchasers to enroll within said first database. However, Official Notice is taken that it is old and well known in the art to solicit a buyer or purchaser through the use of on-line advertisements. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate on-line advertisements into the invention of Giovannoli. One of ordinary skill in the art would have been motivated to do so in order to market and build an on-line business.

Referring to claims 8-10, Giovannoli does not teach that the first database contains an association of condominium purchasers. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of the method would be performed the same regardless of what information the database contained. The difference between the content of the Applicant's database and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the database of Giovannoli because such information does not functionally relate to the steps the claimed method because the subjective interpretation of information does not patentably distinguish the claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

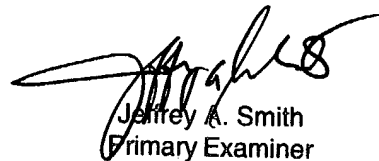
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

June 28, 2004



Jeffrey A. Smith  
Primary Examiner